



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Patent Application of: Eric J. Hansen
and Jesse J. Williams

Group Art Unit: 1751

Serial No.: 09/589,973

Examiner: Derrick G. Hamlin

Filed: June 8, 2000

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For: EXTRACTION CLEANING WITH
OXIDIZING AGENT

Docket No.: 71189-1300

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FEB 03 2004
TC 1700

APPELLANTS REPLY BRIEF

MAIL STOP APPEAL BRIEF - PATENT
Commissioner of Patents
Alexandria, VA 22313-1450

Sir:

Appellants believe that the Examiner has not answered any of the cogent arguments which have been raised by Appellants in their brief. Appellants will not reiterate any of the arguments which they raised in the Appeal Brief but will only meet some of the new issues raised by the Examiner in the Examiner's Answer. In particular, the Examiner raised an issue as to the grouping of the claims and has confounded the issue of the *combinability* of the references with the issue of *patentability* of the appealed claims over a *proper combination* of references. The Examiner further failed to provide any factual basis for his allegation of obviousness for the differences between the claims and the alleged combination of references in the face of evidence to the contrary. These issues will be addressed in this Reply Brief.

GROUPING OF THE CLAIMS

The Examiner has alleged in his answer that the rejection of claims 1-28 must stand or fall together because Appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof, citing 37 C.F.R. § 1.192(c)(7). Contrary to the Examiner's representation, the Appeal Brief does set forth the grouping of the claims and does include reasons in support of the grouping of the claims. There is no specific statement that claims do not stand or fall together. However, the grouping of the claims is a statement that the claims do not stand and fall together. For the record, Appellants assert that claims 1-28 do not stand or fall together because each group of claims has an independent basis for patentability over the cited references. Patentability should be determined on the basis of each of the groups of claims set forth in page of the Appeal Brief.

Furthermore, Appellants gave specific reasons why each group of claims was independently patentable on pages 12-13 of the Appeal Brief. It is therefore clear from Appellants' brief that the claims should be grouped in six groups as set forth in Appellants' brief and the reasons why the grouped claims are independently patentable as required by the Rules.

The Examiner did in fact respond to the grouping of claims and to Appellants' arguments as to the patentability of each of the groups of claims. The Examiner specifically responded to each of the arguments for each of the groups of claims on pages 12 and 13 of the Examiner's Answer. Thus, there is no reason why the Board cannot consider each of the groups of claims in view of the showing that Appellants did comply with the rule and that the Examiner did in fact recognize that the Appellants complied with the rule by responding to each of the arguments that are set forth on pages 12 and 13 of the Appeal Brief.

THE EXAMINER HAS CONFOUNDED THE ISSUES OF THE COMBINABILITY OF
REFERENCES AND THE PATENTABILITY OF THE CLAIMS OVER PROPERLY COMBINED
REFERENCES

In the Examiner's Answer on pages 6-11, the Examiner purports to respond to Appellants issue that the alleged combination of Miracle et al. '282 with Ligman '595 or Sham '612 is inappropriate. However, as the Board will recognize, the Examiner's Answer is replete with references to the claims as an argument as to why the references can be combined. For example, on page 8 of the Examiner's Answer, Examiner states:

... Furthermore, the Appellants uses of the open claim language comprising and has failed to demonstrate that a bleach booster would in fact strip color from the carpet.

Combinability of the references is not dependant on whether the Appellants have used the open claim language "comprising" or "consisting of". The issue is whether the references are properly combined without reference to the claims.

Further, on the bottom of page 9 and the top of page 10, the Examiner responds to Appellants argument that Miracle et al. '282 bleach boosters would include heavy surfactants that would leave a substantial amount of cleaning solution in the carpet and result in a significant resoiling problem. In an attempted response to the Williams Declaration under 37 C.F.R. § 1.132, the Examiner states:

... The Appellant has conducted no experiment using the composition of Miracle to prove this assertion, nor has the Appellant shown superior or unexpected results over the prior art of reference(sic). The Appellant's (sic) also relies (sic) on said Declaration, which is not commensurate in scope as it argues that the bleaching additive would not be an affective (sic) cleaning due to resoling (sic) with out testing any (or various) concentrations.

Here again the Examiner is trying to refute the Declaration of Williams with a reference to the subject matter of the claims. This discussion is inappropriate as to whether the cited references can be properly combined.

THE EXAMINER HAS NOT REFUTED THE EVIDENCE OF THE UNCOMBINABILITY OF REFERENCES

Evidence of the uncombinability of the Miracle et al. '282 reference with either of Ligman '595 or Sham '612 is presented in the Declaration of Jesse Williams under 37 C.F.R. § 1.132. The Examiner has attacked this Declaration with the argument that no tests have been conducted using the Miracle composition in a conventional extraction cleaner. The issue that Mr. Williams addresses in his Declaration is not whether the Miracle composition would actually function in an appropriate manner in the extractor of Sham or Ligman but whether a person having ordinary skill in the art would believe that the Miracle et al. '282 composition *could* be used in either of the Ligman '595 or Sham '612 extractors. Mr. Williams has been qualified in his Declaration as an expert in the art to which the invention pertains and has given his expert opinion as to why the Miracle et al. '282 composition would not be thought to be appropriate for use in a conventional extractor machine to a person having ordinary skill in the art. The Examiner has not presented any evidence to counter the evidence of Mr. Williams.

THE EXAMINER HAS NOT MET HIS BURDEN OF PRESENTING A *PRIMA FACIE* CASE OF OBVIOUSNESS FOR ANY OF THE GROUPS OF CLAIMS

With respect to Examiner's response to Issue 4, that the alleged combination of Miracle et al. '282 with either Ligman '595 or Sham '612 does not meet the claimed invention, the Examiner's arguments on pages 12 and 13 are devoid of any factual support. The Examiner has simply alleged that the differences would be obvious to a person having ordinary skill in the art without any factual support in the references. This is true for each of Appellants' groups of claims.

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CONCLUSION

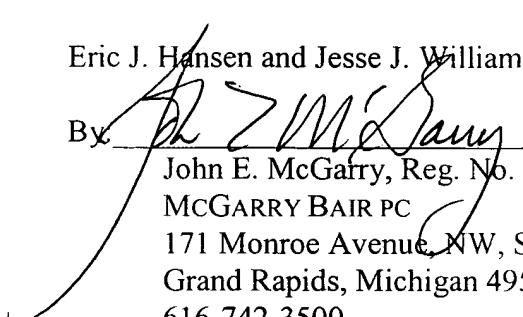
The Examiner has failed to rebut the Appellants' arguments of the Appeal Brief and has not given any reason why the Board should not consider each of the groups of the claims set forth in Appellants' Brief. Reversal of the Examiner is respectfully solicited.

Respectfully submitted,

Eric J. Hansen and Jesse J. Williams

Dated: 1.16.04

By


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